

**REMARKS**

Reconsideration of this application is respectfully requested. Claims 1-8 are pending in the present application. Claims 1-8 stand rejected.

**Claim Rejections – 35 U.S.C. § 103**

Claims 1-8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over **de Hond** (USP 6,002,853) in view of **Towell et al.** (USP 6,647,411). For the reasons set forth in detail below, this rejection is respectfully traversed.

**Prima facie case of obviousness has not been established**

First, it is respectfully submitted that the Office Action has not provided the requisite incentive or motivation for combining the references, as required under §103, and therefore has not established a *prima facie* case of obviousness. More particularly, the Office Action asserts that “it would have been obvious to one of ordinary skill in the art at the time of the invention to include a push-type interface for receiving information in addition to possessing a pull-type interface as taught by **Towell, et al.** in the system of **de Hond**, because both **de Hond** and **Towell, et al.** are from the same field of endeavour of information transmittal and download. The motivation of doing so is for the extension and diversification of **de Hond**’s invention where a new information type can be used” [emphasis added].

Initially, it is respectfully submitted that, “being in the same field of endeavour” does not meet the requisite standard of motivation for combining references under §103. As is well

established, the motivation for combining prior art references to arrive at the claimed invention must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Knowledge generally available to one of ordinary skill in the art is normally demonstrated by a reference teaching. Being in the same field of endeavour has not been found to meet the requisite teaching or suggestion required for combining references under §103.

The only other stated motivation for combining the references is “for the extension and diversification of **de Hond**’s invention, where a new information type can be used.” However, as noted above, §103 requires that there must be a teaching, suggestion or implication in the references supporting the use of a new information type in **de Hond**, and, specifically, there must be a teaching, suggestion or implication supporting the display of push type information in the **de Hond** system. Neither **de Hond** nor **Towell, et al.** teach or suggest extending or diversifying the system disclosed therein such that a new information type can be used. More specifically, **de Hond** does not teach or suggest that push-type information would be used in the system disclosed therein, and vice-versa, **Towell, et al.** do not disclose or suggest that pull-type information would be used in the system disclosed therein.

Therefore, it is respectfully submitted that absent the requisite teaching or suggestion that the **de Hond** and **Towell, et al.** references accommodate another information type (i.e., push-type or pull-type), it is respectfully submitted that the Examiner has impermissibly used the Applicants’ teaching to hunt through the prior art for the claimed elements and combine them as

claimed, which amounts to impermissible hindsight reconstruction of the invention using Applicants' own teachings.

Even if the references are combined, the combination does not result in the claimed invention

On page 7, lines 11 – 15 of the Office Action, the Examiner disagrees with the argument that the cited prior art does not disclose “summaries described in a predetermined common format.” The Examiner’s reasoning is that **Towell et al.** “teaches the use of various formats . . . , which constitutes a common format to the summaries extracted from de Hond’s . . . invention.”

In column 2, lines 45 – 47 **Towell et al.** teach that the data may be various types of data, for example, “video data, audio data, text data, or other suitable type of data.” Thus, it is apparently the Examiner’s position that because **Towell et al.** discloses a variety of types of data, one of those types of data would happen to have the same format as the format of information used by **de Hond**.

Applicants respectfully disagree with the Examiner’s position on page 7, lines 11 – 15 of the Office Action because it ignores an important aspect of the present invention, that is, the position ignores that the claimed common format is “**predetermined.**” More specifically, in accordance with the present invention, the common format is *predetermined* (i.e., set in advance) in order to enable display of summaries of respective information having different formats on the same viewer.

As described, for example, on pages 6 and 7 of the present application, and as presently claimed, by extracting summaries having a predetermined common format from information

from the respective inputted push-type information, and by downloading summaries of pull-type information, which summaries of pull-type information are described in the predetermined common format, summaries of the different types of information can be displayed on the same viewer (claimed summary list display means).

Neither **de Hond** nor **Towell et al.** disclose or suggest that the format of the “summaries” disclosed in these respective references is a *predetermined* common format. In fact, because the Examiner relies on one reference (**de Hond**) to teach a pull-type information interface and another reference (**Towell et al.**) to teach a push-type information interface, it is submitted that there is no predetermination of a common format between references. There is simply no teaching in the references, whether taken alone or in combination, that the formats of *both* the push-type information and the pull-type information have a predetermined common format.

Moreover, it is submitted that even if the various formats of information disclosed in **de Hond** and **Towell et al.** *happen* to include a format that is commonly described by the references, this does not satisfy the claim recitation that the pull-type information summaries *and* the push-type information summaries having a *predetermined* common format are downloaded and extracted, respectively.

Further, on page 7, line 16 – page 8, line 6, of the Office Action, the Examiner disagrees with the argument that the “present invention is capable of handling information provided in various formats for display on a single viewer...,” asserting that “the present invention’s capability to handle different information formats on a single viewer is irrelevant, as it is not a claimed limitation.”

Although the claims do not *specifically* use the language “handling different information formats on a single viewer,” claim 1 recites a “summary list display means” for displaying a list of (1) “searched summaries” and (2) “the summaries satisfying said search conditions and downloaded from the pull type information distribution medium.” According to claim 1, the “searched summaries” is *push type* information, while “the summaries satisfying said search conditions and downloaded from the pull type information distribution medium” is *pull type* information. Thus, the present claim 1 recites a display means for displaying a list of summaries of both push type information and pull type information. None of the cited prior art, whether taken alone or in combination disclose or suggest means for displaying a list of summaries of push-type information and the pull-type information. Applicants provide the only teaching of this feature

Further, the Examiner considers the information stored in the caching device 110 of **Towell et al.** to be push type information, and the viewing of the on-demand information to correspond to the extracted summaries (see Office Action, page 3, lines 16 -18). However, if the viewed on-demand information is considered an extracted summary, then **Towell et al.** clearly does not teach the claimed “*summary list display means for displaying a list of said searched summaries ...*.” Note, according to claim 1, the summaries extracted from the push-type information are stored in a summary storage means and then searched. More particularly, if the Examiner considers the “extracted summaries” to be viewing of the on-demand information, then there is simply nothing disclosed in **Towell et al.** that indicates a user can search the extracted summaries (i.e., viewed on-demand information) and display a list of the searched summaries.

Further, if the Examiner asserts that the features of searching and displaying a list of summaries are inherent in **Towell et al.**, the Examiner is requested to provide extrinsic evidence to demonstrate that these features are necessarily present in the reference.

For all the reasons set forth above, it is submitted that claim 1, and claims dependent therefrom, patentably distinguish over the cited prior art and define allowable subject matter. Reconsideration and withdrawal of the rejection under §103 are respectfully requested.

### **CONCLUSION**

In view of the foregoing amendments and accompanying remarks, it is submitted that all pending claims are in condition allowance. A prompt and favorable reconsideration of the rejection and an indication of allowability of all pending claims are earnestly solicited.

If the Examiner believes that there are issues remaining to be resolved in this application, the Examiner is invited to contact the undersigned attorney at the telephone number indicated below to arrange for an interview to expedite and complete prosecution of this case.

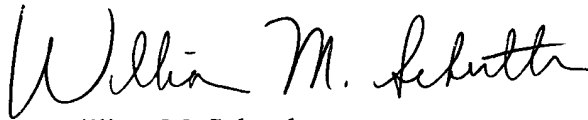
Application No. 09/777,010  
Group Art Unit: 2145

Response under 37 C.F.R. § 1.116  
Attorney Docket No.: 010122

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

**WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP**

A handwritten signature in black ink, reading "William M. Schertler". The signature is fluid and cursive, with the first name "William" being the most prominent part.

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